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REMARKS

This reply is in response to the Final Office Action dated July 26, 2006. Claims 1, 5, 6, 14, 15, 27 and 29-39 are pending in the application and stand rejected. Applicant has cancelled claims 33 and 39 without prejudice. Cancellation of those claims is not an admission of non-patentability or new matter. Applicant has simply cancelled claims 33 and 39 to place the application in condition for allowance and/or to reduce issues for appeal. Entry of the foregoing amendment and reconsideration of the claims is respectfully requested.

Claims 33 and 39 stand rejected under 35 U.S.C. § 112, first paragraph. Applicant has cancelled those claims for reasons set forth above, obviating this rejection. Withdrawal of the rejection is respectfully requested.

Claims 32 and 35-37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Carson (U.S. Patent No. 4,505,758) hereafter "Carson." Claims 33 and 39 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carson. The Examiner states that Carson teaches a process where electric current is continually applied over a time interval of less than 5 minutes.

Applicant respectfully traverses the rejection. Electric charge is not synonymous and is not interchangeable with voltage and/or electric current. Carson does not teach, show or suggest an electric charge. An electric charge is required in every claim. For at least this reason, Carson does not teach, show or suggest the claimed invention.

Furthermore, Carson discloses a process for removing wax build up on cooler internals by applying an electric current, not electric charge, to only a portion of the cooler at a time. See, e.g. Carson at col. 3, ll. 41-43. The wax is removed by resistive heating. The heat is applied in intermittent time intervals of less than 5 minutes, not a continual or constant application. See, e.g. Carson at col. 3, ll. 59-62. The Examiner is erroneous to suggest that "electric current is continually applied over a time interval of less than 5 minutes" teaches, shows or suggests applying a continual electric charge, as required in the claims, or a continual electric current as suggested by the Examiner. Such suggestion is only based on hindsight. Further, Carson teaches preferred time intervals of less than one minute. See, e.g. Carson at col. 3, ll. 59-62. It is clear that Carson does not disclose anything of a continual manner. A continuous or uninterrupted

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process for less than 5 minutes, preferably less than one minutes, is not a "continual" process, as these terms are known in the relevant art. A trusted dictionary definition as evidence thereof has been previously provided to the Examiner and is of the record.

Moreover, a second application of the electric current as taught in Carson would not be continually applied with respect to the first application. See, e.g. Carson at col. 4, ll. 51-60. Therefore, it is unfathomable how the Examiner maintains the rejection. Carson simply does not teach or suggest applying a continual electric charge as that term is known and used in the art. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 1, 5-6, 27, 29-31, 34 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carson in view of Harms (U.S. Patent No. 3,933,606) hereafter "Harms." The Examiner states that it would have been obvious "to modify the process of the Carson reference to include an electric charge magnitude adjustment step as taught in the Harms reference in order to effect a desired degree of contaminant removal in the fluid being treated."

Applicant respectfully traverses the rejection. Carson has been discussed and distinguished above. As mentioned, Carson does not teach, show or suggest electrical charge. Therefore, a combination of those references does not teach, show or suggest the claimed invention.

Further, Harms discloses a water treatment process. Harms does not teach, show or suggest processing a hydrocarbon. Water and hydrocarbons are completely different in terms of polarity, physical properties, volatility and flammability, just to name a few significant differences. Therefore, there is no reasonable expectation from the references themselves that the process of Carson could be modified according to the teachings of Harms. Nor would one of ordinary skill in the art interested in hydrocarbon processing look to Harms which relates to water treatment. These are non-analogous arts.

Accordingly, such modification proposed by the Examiner is not motivated by a combination of Harms and Carson. As stated above, Carson uses the work from short, intermittent applications of current to remove or clean accumulated, solidified paraffins within a cooler. An electric charge as a result of the applied voltage and resulting current would have no effect on the solidified paraffins. As a result, Carson has no use for electric charge and makes no reference to an electric charge. In fact, a "magnitude adjustment step" in Carson would have no

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effect on Carson's process of melting accumulated paraffins, which are non-polar. As mentioned previously, electric charge is not synonymous and is not interchangeable with voltage and/or current. Therefore, such modification is not suggested by the references.

The Examiner is also kindly reminded that the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Furthermore, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). As discussed above, any longer duration of current/voltage to the cooler of Carson would impart too much heat and would render the cooler unsatisfactory for its intended purpose which is cooling a non-polar process stream. As such, Carson has no use for electric charge and is silent in that regard. Therefore, the Examiner has not established a *prima facie* case of obviousness. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carson in view of Harms, and further in view of Sivavec et al. (U.S. Patent 6,451,210) hereafter "Sivavec." Applicant traverses the rejection. The argument above regarding claim 1 equally applies to claims 14-15 since claims 14-15 each include the limitations of claim 1. Furthermore, Carson and Harms have been discussed and distinguished above. Sivavec adds nothing to the deficiencies of Carson and Harms. Moreover, the Examiner has failed to state why the combination of Sivavec, Carson and Harms is suggested by the references themselves. The Examiner simply proposes a combination of their teaching and concludes it is all obvious. That hindsight reasoning is not the standard under 35 U.S.C. § 103.

The Examiner is kindly reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Lee, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002). In other words, the Examiner must "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."

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See In re Kahn 04-1616 (Fed. Cir. March 22, 2006). If no explanation is provided, then it is inferred that the Examiner used hindsight. See Id. Hindsight cannot support a proper rejection under 35 U.S.C. § 103. Accordingly, claims 14-15 are in condition for allowance. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. Applicant invites the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been addressed to the Examiner's satisfaction.

Respectfully submitted,



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